

U.S.S.N. 10/621,131

-6-

ML 0166 PUS

REMARKS

Claims 1-3 and 6-7 are currently pending in the above application.

Claims 1-3, 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Englander (U.S. Patent No. 6,636,822) in view of either Foster (U.S. Patent No. 2,877,686) or Bateman (U.S. Patent No. 3,610,736). Applicant respectfully traverses the Examiner's rejection for reasons stated in their January 11, 2006 Response.

In his Response to the Arguments Section, the Examiner makes several inaccurate or otherwise misleading statements. First, the Examiner states that Applicant did not specifically traverse the motivation to combine either Foster or Bateman with Englander. Applicant respectfully disagrees, and points the Examiner to the final paragraph of the response, in which the Applicant noted: "there is no motivation to modify Englander to include an electronic actuator and electronic controller system, contrary to the Examiner's position, because it serves no useful purpose in certifying regulatory compliance." To the extent that this is not a specific traversal, Applicant respectfully states herein that Applicant specifically traverses the Examiner determination that there is motivation to combine the references.

In addition, the Examiner states that there is "no requirement that motivation to combine the teaching of references be found in the primary reference." However, Section 2143 of the Manual of Patent Examination and Procedure specifically states that "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the reference or to combine reference teachings." Thus, contrary to the Examiner's position, there is a requirement that motivate must be found to coming any reference teaching, including the primary reference.

Moreover, the Examiner has repeatedly mischaracterized what is a properly combinable reference for motivational purposes. Section 2143.01 teaches that there are three possible sources for motivation to combine references: the nature of the

U.S.S.N. 10/621,131

-7-

ML 0166 PUS

problem to be solved, the teachings of the prior art, and the knowledge of person of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In applying the law to the facts in this case, one must first examine the nature of the problem in Englander, namely certifying mirror compliance using artificial visualization. Englander is not concerned about the particular configuration of the mirror, the mirror support structure, and/or whether the mirror is electronically adjustable from inside the cab of the school bus. Englander is merely concerned with testing whatever type mirror assembly is provided, via artificial visualization, to ensure regulatory compliance with a predetermination certification standard. It matters not to the invention of Englander whether the mirror is a crossview mirror, a rearview mirror, a side mirror, or an electronically-controlled version of any of these mirrors, it only matters that whatever configuration of mirror is being tested according to the method of Englander to see if it meets a particular predetermined mirror mounting and visual orientation standard. Further, and most important to this inquiry, it does not matter if, much less how, the mirror is moveable, much less moveable using electronic control. Englander is only concerned with testing the mirror in its present configuration. Thus for the Examiner to take the monumental leap to "solve" a problem that is not present in Englander is inappropriate. Contrary to the Examiner's conclusion, there is no motivation to add an electronic control element to the software based mirror testing method taught in Englander, and therefore the Examiner has not proven the first possible source for motivation as required in *In re Rouffet*.

With regards to the second and third source of motivation discussed in *In re Rouffet*, the Examiner state support for motivation to combine would be that "motorized adjustment of the mirror is more convenient and quicker than manual adjustment." Applicant notes that "[W]here the references teach every element of the claimed invention, however without the motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper. *In re Rouffet*, at 1357. Englander, as stated above, is directed to a method for testing mirrors, not to the inner workings or manipulation of the mirrors, and as such any modification that would be properly combinable should be directed towards improvements to the method, not to improvements to the mirror structure itself. Thus, even though the combination of

U.S.S.N. 10/621,131

-8-

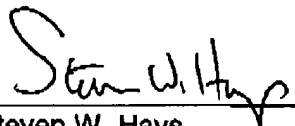
ML 0166 PUS

Englander with either Foster or Bateman teaches all the elements, and can be combined to form the present invention by one of skill in the art, these facts are insufficient to support a *prima facie* case of obviousness in the absence of motivation to combine the references. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). As stated above, there is no motivation to alter Englander with either Foster or Bateman to arrive at the present invention, and thus the Examiner has failed to establish a *prima facie* case of obviousness to support the rejection of claims 1-3, 6 and 7. While adding motorized control may be "convenient and "quicker," this is not the test for determining motivation to combine. Proper combinable references to Englander would be directed to improving the visualization method, not to providing a more convenient way to move a mirror during the certification process (where a method is available). Reconsideration of these claims 1-3, 6 and 7 is respectfully requested.

The Examiner is invited to telephone the Applicant's undersigned attorney at (248) 223-9500 if any unresolved matters remain.

Respectfully submitted,

ARTZ & ARTZ, P.C.

By: 

Steven W. Hays
Reg. No. 41,823
28333 Telegraph Road
Suite 250
Southfield, MI 48034
(248) 223-9500

Dated: May 19, 2006